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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,705	01/19/2007	Katsumi Ishitani	295894US0PCT	3044
22850	7590	03/26/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
MCAVOY, ELLEN M				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
03/26/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/591,705

Applicant(s)

ICHTANI ET AL.

Examiner

Ellen M. McAvoy

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Claim Objections

Claims 4 and 5 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend upon another multiple dependent claim. See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hewson et al (6,239,082), Sweet (US 2005/0039832) and Ichitani et al (7,347,927), considered separately.

Hewson et al ["Hewson"] disclose petroleum quench oil effective for high speed cooling of heated metals and metal hardening, especially steel. The petroleum quench oil contains natural or synthetic base oils having a minimum flash point of about 120°C and having a viscosity between 5 and 100 cSt at 40°C; one such base oil is a solvent refined paraffinic base stock. See column 1, lines 4-42. The petroleum quench oil additionally includes a quench speed accelerator additive system containing (a) a polymer or copolymer having alkylene groups such as polyisobutylene, and (b) a succinic acid or succinic anhydride functionalized polymer or copolymer having alkylene groups. The examiner is of the position that the petroleum quench oil of Hewson meets the limitations

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of the claimed quenching oil when the vapor blanket breaking agent is a polyolefin such as polyisobutylene. Applicants' open-ended claim language "comprising" allows for the addition of other additives to the quenching oil such as the succinic acid or succinic anhydride functionalized polymer or copolymer having alkylene groups of Hewson.

Sweet et al ["Sweet"] disclose quenching oil compositions comprising (1) a base oil having a kinematic viscosity at 40°C ranging from about 4 to about 45 mm²/s and having a saturated content from about 80% to 100%, (2) an alkali metal salt of saligenin derivative and, optionally, further comprising at least one of (3) an aliphatic polyolefin having a molecular weight ranging from about 300 to about 10,000, (4) a metal salt component, and (5) succinic ester compounds. See page 2, paragraphs [0019] to [0026]. The examiner is of the position that the quenching oil compositions of Sweet meet the limitations of the claimed quenching oil when the vapor blanket breaking agent is a polyolefin. Applicants' open-ended claim language "comprising" allows for the addition of other additives to the quenching oil such as components (2), (4) and (5) of Sweet.

Ichitani et al ["Ichitani"] disclose a heat treatment oil composition comprising a mixed base oil containing 50-95 weight % of (A) a low viscosity base oil with a kinematic viscosity of 5-60 mm²/s at 40°C, 50-5 weight % of (B) a high viscosity base oil with a kinematic viscosity of more than 300 mm²/s at 40°C, and (C) a vapor blanket-breaking agent including ethylene-alpha-olefin copolymers, polyolefins and polymethacrylates. See column 1, line 55 to column 3, line 26. The examiner is of the position that the heat treatment oil composition of Ichitani meets the limitations of the claimed quenching oil. Applicants' open-ended claim language "comprising" allows for

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the addition of other additives to the quenching oil such as the high viscosity base oil of Ichitani.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/
Primary Examiner
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EMcAvoy
March 20, 2009